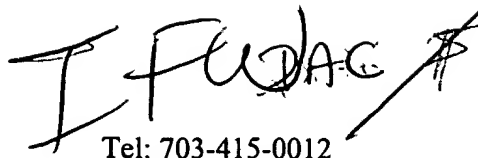


NEIFELD IP LAW, P.C.  
4813-B Eisenhower Avenue  
Alexandria, Virginia 22304

  
Tel: 703-415-0012  
Fax: 703-415-0013  
Email: rneifeld@Neifeld.com  
Web: [www.Neifeld.com](http://www.Neifeld.com)

**37 CFR 1.7(c) FILING RECEIPT AND  
TRANSMITTAL LETTER WITH  
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

Neifeld Docket No.: HENN0012UPCT-US  
US/PCT Application/Patent No.: 09/485,734  
Priority Data: PCT/DE98/01178  
Inventor: Frank Puttkammer  
Title: Constituting security elements with optical diffraction effects, and device for controlling such elements

Client Ref.: 1.158.US  
US/PCT File/Issue Date: 2/14/00  
USPTO Confirmation No.: 2153

**THE FOLLOWING HAS BEEN RECEIVED IN THE U.S. PATENT OFFICE ON  
THE DATE STAMPED HEREON:**

Check for \$750.00  
37 CFR 1.7(c) Filing Receipt and Transmittal Letter with Authorization to Charge Deposit Account (1 Page, In Duplicate))  
Amendment Cover Letter (1 page in duplicate)  
37 CFR 1.137 Petition to Revive Due to Unintentional Abandonment (40 pages)  
37 CFR 1.111 Amendment (19 pages)  
Formal Drawings (4 pages)

**RECEIVED**

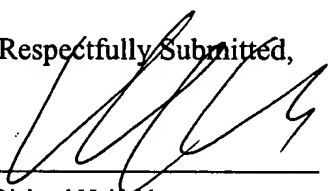
**MAR 23 2006**

**OFFICE OF PETITIONS**

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.

3/17/06  
DATE

Respectfully Submitted,

  
Richard Neifeld  
Registration No. 35,299  
Attorney of Record

	PcLaw Matter	Lawyer	Amount	Explanation	Date Entered	Initials
Fees:	HENN0002	RAN	300.00	HENN0012UPCT-US firm charge for filing petition to revive application.	3/13/06	RLB
Fees:						
	PcLaw Matter	G/L Account	Amount	Explanation	Date Entered	Initials
Disbursements:	HENN0002	5010	750.00	HENN0012UPCT-US government fee for filing a petition to revive application.	3/13/06	RLB

Printed: September 30, 2005 (1:31pm)

Y:\Info\FirmForms\Firms\_Patent\US\Templates-DoNotUse\Combined\_37\_CFR1\_6\_FilingReceiptOfCorrespondence\_TransmittalLetter.wpd

NEIFELD REF.: HENN0012UPCT-US

IN RE APPLICATION OF: PUTTKAMMER et al.

APPLICATION NO: 09485,734

FILED: 2/14/2000

FOR: Constituting security element with optical diffraction effect and device for controlling such elements

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313



RECEIVED

MAR 23 2006

OFFICE OF PETITIONS

**AMENDMENT COVER LETTER  
INCLUDING AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

SIR:

Transmitted herewith is an amendment in the above-identified application.

- ☐ No additional fee is required
- ☒ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement previously submitted.
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement submitted herewith.
- ☒ Additional documents filed herewith: 37 CFR Petition to Revive Due to Unintentional Abandonment  
37 CFR 1.111 Amendment  
37 CFR 1.85 Submission of Formal Drawings

The Fee has been calculated as shown below:

CLAIMS	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATIONS	
TOTAL	22	MINUS	22	0	× \$50 =	0	
INDEPENDENT	1	MINUS	3	0	× \$200 =	0	
		<input checked="" type="checkbox"/> MULTIPLE DEPENDENT CLAIMS				+ \$360 =	0
		TOTAL OF ABOVE CALCULATIONS					
		<input checked="" type="checkbox"/> Reduction by 50% for filing by Small Entity					
		<input type="checkbox"/> Recordation of Assignment				+ \$40 =	
		<input type="checkbox"/> Petition for Extension of Time: 1 Month				+ \$120 =	
		<input type="checkbox"/> 2 Months				+ \$450 =	
		<input type="checkbox"/> 4 Months				+ \$1,020 =	
		<input type="checkbox"/> 4 Months				+ \$1,590 =	
		<input type="checkbox"/> Terminal Disclaimer				+ \$130 =	
		<input type="checkbox"/> Information Disclosure Statement Prior to Final				+ \$180 =	
		<input checked="" type="checkbox"/> Other: <u>Fees for Petition to Revive</u>					750.0
		TOTAL					750.0

☒ A check including the amount of \$750.00 is attached.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this cover letter is attached.

Respectfully Submitted,

3/14/06  
Date

Richard A. Neifeld, Ph.D.  
Registration No. 35,299  
Attorney of Record



NEIFELD REF: HENN0012UPCT-US

(HENNING REF: 1.158.US)

(HORMAN REF: 990350)

APPLICATION NO: 09/485,734

Filed: 2/14/2000

TITLE: Constituting security elements with optical diffraction effects, and device for controlling such elements

Sir: Enclosed please find the following document.

**37 CFR 1.37 PETITION TO REVIVE DUE TO UNINTENTIONAL ABANDONMENT**

**RECEIVED**

**MAR 23 2006**

**OFFICE OF PETITIONS**

03/21/2006 SZEWDIE1 00000031 09485734

01 FC:2453

750.00 OP

**I. Relief Requested**

That applicant requests that this application be revived due to an unintentional abandonment.

**II. Statement of Material Facts**

On Tuesday, November 22, 2005 5:43 AM, I received an email from German patent attorney Joachim Brunnotte , stating that:

Rick

Another question: Would you be able to handle some existing US applications (list see below) of a new client of our firm, and possibly new cases in the future?

The client is a joint client of another German patent attorney, Martin Hennings, and of our firm. Martin is a friend and is a part time free lance attorney. However, he is a full time patent professional, also working in the patent department of Bombardier Transportation GmbH, Germany.

Martin will handle all prosecution work on his own, except some special cases, for example oppositions and infringement, which are handled jointly by Martin and our firm.

Martin has taken over representation of the client recently. He knows the client from his time as a trainee, some years ago. The attorney who trained Martin is about to retire.

Our joint client is:

WHD elektronische Prueftechnik GmbH, Industriestrasse 19, 01129 Dresden, Germany

The main technical field of WHD is verifying authenticity of money (banknotes and coins), or more generally sensors and software for this and similar purposes.

If there is no conflict and if you have time to handle these cases,

please:

- contact Martin to set up the direct relationship
- please perform a preliminary check on the status of the US applications listed below. Our concern is that some of the cases which have been handled by another US attorney (Hormann) are abandoned. The client would like to know if these cases can be revived.

As far as I know, Mr Hormann will retire soon. In any case, the client would not like him to continue as representative.

Best regards,

Joachim

Joachim's email to me included a copy of a prior email to him from email address [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) dated "Dienstag, 22. November 2005 09:23" stating that:

> Dear Achim,

>

> as discussed during our recent telephone conversation please find below

a

> list of US patent applications by WHD, represented by US attorney Mr

> Hormann:

>

> 08/894,766

> 09/931,694

> 09/485,734

> 09/423,275

> 10/619,038

> 09/485,750

> 09/719,881  
> 10/110,600  
> 10/469,795  
> 10/469,652  
> 10/469,794  
>  
> 1. WHD is asking for a proposal for another US Representative. 2.  
> Which of above-mentioned applications are lapsed without  
possibility to  
> re-instate?  
> 3. Which of above-mentioned applications could be re-instated with  
> additional effort? 4. What should be done to enforce claims by WHD  
> against Mr Hormann?  
>  
> Best regards,  
>  
> Martin  
>  
>  
> Dipl.-Ing. Martin Hennings  
> Patentanwalt - European Patent Attorney  
> Fritz-Kühn-Str. 37b  
> D-12526 Berlin  
> Germany  
> Tel.: +49/(0)30/233 67 261  
> Fax: +49/(0)30/233 67 260  
> mob.: +49/(0)179/52 52 588  
> e-mail: martin.hennings@arcor.de

On Tuesday, November 22, 2005 12:16 PM, I sent an email to Joachim and Martin stating that:

Joachim and Martin -

In fact, some of the US patent applications you identified are now abandoned. I have the following information, which I will also use to complete our internal conflict check. Please note that applications unintentionally abandoned are revivable, but there are significant fees, and you must be sure that the abandonment was in fact not intentional on the part of the applicant or their representative. thanks, Rick

Information on published patent applications and some others is publicly available. Information on all other applications remains secret until and unless the application issues. Based upon the information provided by the USPTO, here is the status of the applications in Joachim's email and corresponding application publications.

08/894,766 - not publicly available.

09/931,694 - abandoned; published as US 2001-0054901 A1

09/485,734 - not publicly available.

09/423,275 - abandoned; not published.

10/619,038 - Abandoned; published as US 2004-0012773 A1

09/485,750 - not publicly available.

09/719,881 - not publicly available.

10/110,600 - not publicly available.

10/469,795 - Abandoned; published as US 2004-0101664 A1

10/469,652 - Abandoned; published as US 2004-0096648 A1

10/469,794 - Abandoned; published as US 2004-0105957 A1

Here are the titles and abstract of the publications listed above.

US 2001-0054901 A1

Method of testing documents provided with optico-diffractively effective markings

Abstract

The invention relates to a method of examining the authenticity of a document provided with an optico-diffractively effective element or hologram by subjecting the hologram to capacitive coupling of a voltage and deriving a signal representative of the voltage for comparison with a reference signal representative of a hologram of an authentic document. The method may be improved by providing, between individual segments of the hologram, additional security indicia providing a signal in response to being irradiated by electromagnetic radiation of a predetermined frequency.

US 2004-0012773 A1

Security element structure for documents, devices for checking documents with such security elements, method of the use thereof

Abstract

A structure of a security element for documents provided with a combination of differently reacting or responding security features and functional designs, including conductive, magnetic and diffractive ones, which render it difficult or impossible for counterfeiters to discover the functioning of the security element.

US 2004-0101664 A1

Security features

Abstract



The invention relates to security features, preferably tear strips or threads for the identification by the manufacturer or authorized control agents of products. The security features in accordance with the invention are made up of different components, encoding means and electrically conductive layers, whereby they are connected in different arrangements to a support substrate. Layers of known per se electrically conductive polymers are utilized. In accordance with the invention, the security features are tear strips which are connected to a package, for instance by pressing, glueing or sealing. The security features constitute insurmountable technological obstacles for a forger.

US 2004-0096648 A1

Security strips

Abstract

The invention relates to security strips for identifying the genuineness of sheet material such as documents, securities and banknotes. The security strips in accordance with the invention are constructed of several different components, encoding means and electrically conductive layers connected in different arrangements on a support substrate. Layers of known per se electrically conductive polymers are being used. The security strips are applied on the sheet material or they are integrated in the sheet material. These security strips constitute insurmountable technological obstacles for a forger.

US 2004-0105957 A1

Security strips

## Abstract

The invention relates to security strips for identifying the genuineness of sheet material such as documents, securities and banknotes. The security strips in accordance with the invention are constructed of several different components, encoding means and electrically conductive layers connected in different arrangements on a support substrate. Layers of known per se electrically conductive polymers are being used. The security strips are applied on the sheet material or they are integrated in the sheet material. These security strips constitute insurmountable technological obstacles for a forger.

On Tuesday 11/22/2005 5:41 PM, I sent an email to Martin Hennings and Joachim Brunnotte's email addresses stating that:

Martin - This email addresses your original questions to Joachim.

You asked about the possibility of reviving abandoned applications. Reviving is only possible if abandonment was unintentional. Moreover, case law indicates that failure to ACT PROMPTLY after recognizing an application or patent has been abandoned can prevent revival. However, since I cannot access the official records for some of the applications identified to me by application number, I cannot advise on those cases the legal criteria applicable for revival. Generally speaking, the revival attempt includes (1) filing a petition to revive an abandoned application (under either the 37 CFR 1.137(a) unavoidable legal standard or the 37 CFR 1.137(b) unintentional legal standard) along with a suitable response to the USPTO paper to which the applicant failed to respond. The "unavoidable" standard must be met in some situations, such as an extended period of abandonment.

It is (from my knowledge of relevant case law and personal experience in

petitioning for revival under this standard) extremely difficult and very very expensive to petition under the "unavoidable" standard. Such a petition requires submission of factual evidence, declarations from fact witnesses, and synthesis of legal argument explaining why the facts show abandonment was "unavoidable" as "unavoidable" is defined by case law.

It is easy to petition for revival under the unintentional legal standard, because all that the petitioner is required to do is assert that the delay was unintentional. However, the assertion must be true, and I must know it to be true to make such a representation. Thus, while the petition under the unintentional standard is far less expensive, it requires an investigation as to the facts surrounding the abandonment. If the conclusion as to whether the abandonment meets the criteria for unintentional abandonment is unclear, then the petition needs to list the facts supporting that conclusion, (1) for me to sign it, and (2) to eviscerate an argument in subsequent litigation that the patent was revived fraudulently.

Since you now know that 6 of the 11 applications are abandoned and you know that I cannot determine whether the other 5 are abandoned, you need to act with all due haste - to take whatever actions are necessary to get to the facts of which applications were unintentionally abandoned, and petition to revive those application, or decide to forego the attempt to revive.

Enclosed is a form for transferring power of attorney to my firm. However, it is insufficient. It is insufficient because it does not include the proof of ownership by WHD elektronische Prueftechnik GmbH, Industriestrasse 19, 01129 Dresden, Germany of those applications. To prove ownership, you need copies of the proof of recording of the assignments from the inventors to WHD elektronische Prueftechnik GmbH, Industriestrasse 19, 01129 Dresden, Germany in each case, and to provide those to me along with the executed form. You should have received from the prosecuting attorney a "Recordation form cover sheet" with USPTO stamped information on the front listing the "Reel" number

and the "Frame" number. That document, in each application, is what I need to take over prosecution of the applications.

If you do not know status of the applications, once I have power of attorney, I can get copies of the USPTO's official file copies of the currently unavailable applications.

I can at this time obtain copies (or review online) the files of the publicly available applications.

The other alternative is for you to order the existing prosecuting attorney to forward originals or copies of his office files (referred to as attorney files) to me. However, I expect that is either not practical or possible, and I expect those files to be unreliable in any case.

Note: petitions to revive under the unintentional standard noted above would require me to discuss and obtain information from the current prosecuting attorney regarding "intent". I have the following information for this person, based upon the USPTO records. Please advise if it is accurate.

Hormann, Karl

Law Offices Of Karl Hormann

P O Box 381516

86 Sparks St

Cambridge MA US 02238

617-491-8867

26470

Attorney

Your final question was "4. What should be done to enforce claims by WHD against Mr Hormann?"

The answer is manifold. Basically, you can withhold whatever fees you have not yet paid him (at risk of him suing you), sue him for negligence in a U.S. court (at great expense), file a complaint against him with the Office of Enrollment and Discipline, of the USPTO (the patent bar), and file a complaint

with the BAR of any state in which he is registered to practice law. The BAR complaints will not result in monetary recovery. A suit in court would of course require proof of damages, and damages other than my costs in picking up the pieces of the mess, are very difficult to prove for lost otherwise patentable rights. Or, you can charge him privately and obtain a settlement from him privately, but that is also unlikely.

Please let me know if you have further questions. thanks, RICK

On Wednesday 11/23/2005 10:27 AM, I received an email from [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating in part that:

Rick,

thanks for your Emails with the valuable information! I confirm receipt and will contact WHD to discuss the issues.

Regarding my Email addresses please use in future only the following:  
[martin.hennings@arcor.de](mailto:martin.hennings@arcor.de)

Thanks and best regards,  
Martin

On Thursday 12/8/2005 10:13 AM, I received an email from [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating that:

Rick,

according to our recent email communication please find attached all available official documents or copies thereof.

Please try to get all necessary information according to all US applications listed in our previous email, especially to those which are not publicly available:

08/894,766 - not publicly available (my ref: 1.099.US) 09/931,694 - abandoned; published as US 2001-0054901 A1 (my ref: 1.157.US) 09/485,734 -

not publicly available (my ref: 1.158.US) 09/423,275 - abandoned; not published (my ref: 1.159.US1) 10/619,038 - abandoned; published as US 2004-0012773 A1 (my ref: 1.159.US2) 09/485,750 - not publicly available (my ref: 1.160.US) 09/719,881 - not publicly available (my ref: 1.197.US) 10/110,600 - not publicly available (my ref: 1.239.US) 10/469,795 - abandoned; published as US 2004-0101664 A1 (my ref: 1.258.US) 10/469,652 - abandoned; published as US 2004-0096648 A1 (my ref: 1.259.US) 10/469,794 - abandoned; published as US 2004-0105957 A1 (my ref: 1.260.US)

From the files I learnt that it was agreed to abandon 10/469,794 in case that 10/469,795 will be maintained and Mr Hormann was instructed to proceed in such a way. Nevertheless in both cases WHD is not interested in a revival.

Furthermore please try to revive following US applications:

09/931,694 - abandoned; published as US 2001-0054901 A1 (my ref: 1.157.US) 09/423,275 - abandoned; not published (my ref: 1.159.US1) 10/619,038 - abandoned; published as US 2004-0012773 A1 (my ref: 1.159.US2) 10/469,652 - abandoned; published as US 2004-0096648 A1 (my ref: 1.259.US)

In case that you find more abandoned cases please inform me to discuss this with WHD.

In addition I confirm that your indicated information regarding Mr Karl Hormann, based upon USPTO records, are correct:

Hormann, Karl

Law Offices Of Karl Hormann

P O Box 381516

86 Sparks St

Cambridge MA US 02238

617-491-8867 (Tel.)

617-491-8877 (Fax.)

26470

Attorney

Please find attached a power of attorney according to your form which you already sent to me.

Furthermore please provide me also with a Power of Attorney to be signed by WHD according to following US patent: US 5,911,298 (08/952,405) (my ref: 1.106.US)

Best regards,  
Martin

On Thursday 12/8/2005 12:46 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating that:

Martin - Thank you for confirming that you are our privity client; that you are responsible for paying our fees and disbursements.

Attached please find a power of attorney for US 5,911,298 (08/952,405) (my ref: 1.106.US) in both pdf and wpd formats.

Our billing reference relating to portfolio transfer and revival work is HENN0002.

Our billing reference relating to ongoing prosecution work is HENN0003.

We will associate separate Neifeld docket numbers with each application using the "HENN" PREFIX.

Our next step will be to gather information from the USPTO publicly available databases, to piece together the portfolio's applications into patent families, so we can assign docket numbers, and get USPTO records.

thanks, RICK

On December 8, 2005, I drafted and had sent via facsimile to 617-491-8877 a letter to Karl Hormann, Esq., stating that:

Re: PATENT PORTFOLIO OF WHD elektronische

Prueftechnik GmbH, Industriestrasse 19, 01129  
Dresden, Germany - TRANSFER OF FILES

Dear Karl:

Thank you for briefly speaking with me just now. I hope that you remain out of the hospital. Per your verbal request, I am transmitting the following information via fax to your office.

I have been instructed by my client, Martin Hennings, to take over prosecution of all U.S. patent applications and to obtain all patent files for his client WHD elektronische Prueftechnik GmbH. I understand that you currently have those files. I wish to coordinate transfer of the files with you. To that end, I would appreciate receiving (1) a list of each U.S. patent application, pending, issued, or abandoned, (2) a priority claim correspondence showing which applications claim priority, and in particular the type of priority claim as an actual continuation, division, or CIP, and (3) a docket sheet showing upcoming deadlines in each case. That will enable us to logically assign docket numbers by disclosure family and filing type.

I have also been instructed to attempt to revive what WHD believes were unintentionally abandoned applications in its portfolio. As you know, that requires a petition that contains an averment that the abandonment was in fact unintentional. In order to make that averment, I need to know facts relating to intent. Since attorney intent is a factor, and you are the attorney of record, I will need to determine whether, for the applications WHD thinks were unintentionally abandoned, whether your records and recollection agree that the abandonment was unintentional. If your records do agree, then I can in good faith make the averments required in the petitions to revive. Hence, I need to discuss with you the specifics, and obtain either evidence from your files or your written statements confirming whatever your files show and whatever you remember relevant to that



issue.

Please note, respecting petitions to revive, that time is of the essence, since failure to promptly request revival upon noting an unintentional abandonment may result in application of the unavoidable standard to any period of extended delay. Accordingly, I need to act swiftly to ascertain facts regarding the abandoned applications.

Laba Karki, Ph.D., patent agent, and Daniel Sachs, a paralegal, will be assisting me in constructing our files for WHD elektronische Prueftechnik GmbH's patent applications. Rebecca Brimmer, my admin, will probably be setting up the actual docket records in our docketing system. I hope you can facilitate their work in case they have questions for you.

To facilitate communication, please provide me your email address. My email address is [rneifeld@neifeld.com](mailto:rneifeld@neifeld.com).

I look forward to working with you to efficiently expedite this process.  
thanks, RICK

Very truly yours,

Richard A. Neifeld

President, Neifeld IP Law, PC

cc: to Martin Hennings, via email attachment, at [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de).

On Thursday 12/8/2005 1:16 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating that:

The noted excel file is attached. RICK

-----Original Message-----

From: Rick Neifeld.

Sent: Thursday, December 08, 2005 1:15 PM

To: 'martin.hennings@arcor.de'

Cc: Rick Neifeld; Daniel Sachs; Laba Karki; Rebecca Brimmer

Subject: WHDPatentPortfolio\_HENN0001\_051208

Importance: High

NEIFELD REF: HENN0001 (General matters for Martin Hennings)

NEIFELD BILLING REF: HENN0002 (Portfolio and revival work)

Martin - I have been working with Laba on your matter since we spoke (Daniel is out of the office today; but he will assist Laba when he returns). We need to determine the extent of the portfolio, and types of priority claims even to assign our docket numbers. Laba will work on filling in the attached Excel file. It contains the information I deem necessary. He should gather the publicly available information, and the information from your prior emails, into this chart, at latest by tomorrow. Then, you can fill in any of your docket numbers we do not have.

Laba will also determine if there is an image file wrapper (IFW) for each patent application, and if so, download that document to our file system. If not, we will order a photocopy, without any references, just bare prosecution history, from the USPTO's paper records (using our contractors).

I will have our staff go ahead and file the powers of attorney we now have, and request status on each such case.

I will keep you informed on our progress.

thanks, RICK

On Thursday 12/8/2005 1:28 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating that:

Martin - We have updated the spreadsheet to help us track actions in the undocketed matters. The revised spreadsheet is attached. thanks, RICK

On Thursday 12/8/2005 1:41 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating that:

One further update to indicate your instructions to request revival in certain applications. RICK

On Tuesday 12/13/2005 1:40 PM, I sent an email to Laba Karki, a patent agent in my firm, stating that:

Laba - You did not fill in information in the spreadsheet based upon the attachments to Martin's email conveying partial attorney file histories to us. Go back and update the spreadsheet for the applications not publicly available, based upon Martin's attachments. See record 8, which I have started, for example. I expect this finished today. Advise when done.

thanks, RICK

On Tuesday, December 13, 2005 1:26 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de), stating that:

Martin - The attached spreadsheet shows status of our current information on your cases.

Accrued charges to date are about \$2500.

Karl Hormann failed to respond to my facsimile last week. I will have it resent now, couriered now, and also telephone him again now. I am also going to assign Neifeld docket numbers now, assuming the attached excel sheet provides me sufficient information to do so according to our numbering scheme.

Rebecca - Resend to Karl Hormann the FAX we sent last week, and also courier a copy of it to his business address.

thanks, RICK

On Tuesday 12/13/2005 1:43 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de), stating that:

I just spoke briefly with Karl Hormann. He indicated that he did get my fax, but that he was too busy to act on it. He did indicate that he would telephone me tomorrow. thanks, RICK

On Wednesday 12/14/2005 2:59 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de), stating that:

Martin - Karl Hormann has not yet called me back.

Yesterday, I started on a fact section for petitions to revive. However, I was called to home for a medical emergency in the early afternoon.

Today, I reviewed the Excel spreadsheet, made revisions, corrections, and instructed Laba to add some additional information (priority claims made in the US application as filed, and as amended). When that is done, I will be in a position to assign my firm's docket numbers.

I now continue to work on the facts section for the petitions. RICK

On Wednesday 12/14/2005 5:23 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de), stating that:

Martin - I desire additional factual information from you in order to complete the petitions to revive based upon unintentional abandonment. Please answer the following questions in as much detail as you think necessary to explain your understandings and information. Please note that I intend to copy in your response to my email into the facts section of the petitions, so please try to be as accurate as you can. I suggest that you number your answers 1-4 to correspond to my questions 1-4.

1. When did you first become aware that U.S. applications assigned to WHD and that WHD did not intend to abandon were or might be abandoned?

2. Is there any explanation, such as lack of familiarity with US patent practice, or lack of communication of the abandonments from the attorney of record to WHD, explaining why WHD was not earlier aware of the abandonments? In other words, is there a reasonable excuse explaining the delay in action until November 2005?

3. What are the facts and circumstances that resulted in your or WHD becoming aware that U.S. applications assigned to WHD that WHD did not intend to abandon were or might be abandoned?

4. What action did WHD or you take at that point in time WHD or you became aware of the possible unintentional abandonment(keeping in mind that my records for this matter begin with an email from your colleague Joachim Brunnotte on 11/22/2005)?

Thanks, RICK

On 12/16/2005, I received an email from [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) responding to my questions, in which Martin Hennings stated that:

Dear Rick,

Dear Laba,

Thanks for your recent emails.

Please note that in the excel spreadsheet is a little mistake: Instead for revival of 08/894,766 I ask for revival of 09/931,694 according to my email dated 12/8/2005. The case 08/894,766 is one of those where it is not yet clear if it is abandoned or not therefore it is not yet clear if revival is desired.

According to 09/423,274 please find attached all available official documents or copies thereof. 09/931,694 is in fact a continuation in part of 09/423,274. It was decided not to proceed with 09/423,274.

According to your questions 1 to 4 please find below my comments:

1. I was informed by the (at that time) German Representative of WHD, Patent Attorney Mr Wolfgang Heitsch, in a meeting on November 10, 2005. According to my information given by Mr Heitsch, he asked several times Mr Hormann for status information. Because Mr Hormann did not react on that request Mr Heitsch made an online inspection on the website of the USPTO. On December 2, 2005 I received the physical files from Mr Heitsch.

2. I assume that Mr Heitsch believed on information/non-information given to him by Mr Hormann and Mr Heitsch believed until November 2005 that everything is in order and all applications are not abandoned. Therefore it seems to be a lack of communication from Mr Hormann to Mr Heitsch and therefore to WHD.

3. Mr Heitsch informed WHD about the problems with Mr Hormann on November 18, 2005 as well as the unintentionally abandonment according to the information by the online register of the USPTO.

4. On November 18, 2005 in a telephone conversation with WHD I was instructed to propose a new US Representative. According to your information I informed WHD about the status of the US applications on November 24, 2005. On the same day I was instructed by WHD to revive 4 of 6 application which were unintentionally abandoned. For the other 2 applications (which were also unintentionally abandoned) WHD decided not to revive. On December 2, 2005 I received the physical files from Mr Heitsch and collect all official documents from these files. On December 7, 2005 I received the Power of Attorney for the US cases signed by WHD. As you know on December 8, 2005 I sent an Email to you regarding the revival including documents.

Furthermore please find attached a power of attorney signed by WHD according to US patent: US 5,911,298 (08/952,405) (my ref: 1.106.US)

According to the requested specifications as filed unfortunately I did not found these documents.

Best regards,  
Martin

On 12/16/2005, at 2:50 PM I again called Karl Hormann via telephone and left a vm message for him. I also googled his law firm name and eventually found the form page [http://pview.findlaw.com/cmd/profileview?xsl=/xsl/lawyer\\_emailform.xsl&wld\\_id=2624779\\_1&which=email\\_addr:1](http://pview.findlaw.com/cmd/profileview?xsl=/xsl/lawyer_emailform.xsl&wld_id=2624779_1&which=email_addr:1) containing a form input for emailing Karl. In that page I typed the message:

Karl, please contact me asap regarding the WHD portfolio transfer.  
Rick Neifeld, Ph.D. Patent Attorney  
President  
Neifeld IP Law, PC URL: [www.Neifeld.com](http://www.Neifeld.com)  
StockPricePredictor.com, LLC URL: [www.PatentValuePredictor.com](http://www.PatentValuePredictor.com)  
4813-B Eisenhower Avenue  
Alexandria Virginia 22304  
Tel: 703-415-0012  
Fax: 703-415-0013

and then clicked the "Send message" button.

On 12/16/2005, I spent 1.7 hours reviewing the WHD portfolio information, and generating and sending the following to emails.

First, to Martin Hennings, I sent the following text:

NEIFELD REF: HENN0001

Dear Martin:

1. I have corrected and updated our spreadsheet, and I have also assigned my firm's new invention family numbers and corresponding Neifeld IP Law, PC docketing numbers in that spreadsheet. We are now in a position to order files from the USPTO. However, our attempt may still be frustrated due to lack of proof of our power of authority to review abandoned secret files.

2. The spreadsheet shows that we downloaded image file wrappers (IFWs) for 4 applications in which IFWs were available to the public (records 10-14 in our spreadsheet).

3. The spreadsheet shows that IFWs are not available in 9 applications (records 2-10 in our spreadsheet).

3A. However, of those 9 application, PAIR indicates that the following applications are publicly available to the general public for copying from the USPTO.

09/931,694

09/423,274

09/423,275

08/952,405 now USP 5911298

It will cost roughly \$500 to obtain a copy of each application, including my firm's charges. Based upon your prior authorization, and since Mr. Hormann is not responsive, we will not go ahead and order these files.

3b. PAIR records do not exist for the following 5 applications indicating that they are not available to the public.

10/110,600

09/719,881

09/485,750

09/485,734

08/894,766

Copies of these files can only be obtained when proof of authority from



the legal owner exists. Our current power from WHD may or may not be sufficient for the USPTO to provide us a copies of the files. However, we will try to order them now and see what happens.

It will cost roughly \$500 to obtain a copy of each application, including my firm's charges. Based upon your prior authorization, and since Mr. Hormann is not responsive, we will not go ahead and order these files.

5. Our cost for docketing transfer applications, as specified on our fee sheet, is \$250 per application. We will now go ahead and docket in all of the applications, per your prior instructions to take over responsibility for this portfolio.

Please note that, with all of those charges, WHD's costs will certainly exceed \$10. Moreover, since this is year end, and WHD is a new client, I will issue an invoice shortly for services to date, to clean up our firm books.

6. Our next step will be obtaining whatever information we still need to petition to revive specific to each case. Hormann clearly is not cooperating, so I expect no more information from him, and we have to act promptly in any case.

Moreover, any petition to revive must include a response to the outstanding office action to which the application failed to respond which resulted in the abandonment, and the fees required for the petitions to revival, applicable government extension fees, and claims fees and terminal disclaimer fees associated with any response. Hence, we need a copy of any such office action in each case. I will review our client's file (WHD's files and the PAIR files) next, to see if we can ascertain if we have the outstanding office action in each case, and what else we need to do in each case viz a petition to revive. I will keep you informed.

Second, to my staff:

Daniel and Rebecca - Please do not report this using LogAndAuditTrack.

1. Docket in the 13 applications identified in records 2-14 in the spreadsheet using the docket numbers I assigned in column AA in:

Y:\Clients\Hennings\HENN0001\WHDPortfolio\PortfolioSummary\_051208.xls

2. Place corresponding family folders and in them docket number folders in

Y:\Clients\Hennings\HENN0010 TO HENN0020

Laba - Order the files specified below from Burt at PatentGateway via email burt@patentgateway.com.

On 12/19/2005, I noted that Laba Karki had ordered copies of USPTO official files from a contractor, PatentGateway, and exchanged a few emails with Dr. Karki on that issue.

On 12/19/2005, I also began to draft from a generic petition listing relief and facts common to all application for which WHD had requested revival, facts specific to each such case.

On 12/21/2005, based upon the information I and Dr. Karki had gathered, I spent .8 hours setting up application docket records in our firm docketing system for the WHD applications.

On 12/22/2005, I spent 3.0 hours docketing in the WHD applications based upon available information.

I was away on vacation over the Christmas holiday.

On 12/28/2005, I recieved an email from Dr. Karki reporting that the USPTO clerks had reported to him that WHD applications now docketed by our firm as HENN0010UPCT-US; HENN0012UPCT-US; HENN0013UPCT-US; HENN0014UPCT-US; AND HENN0017UPCT-US were also abandoned.

I should note that Dr. Karki was also spending considerable time determining the status and obtaining files (via contract service or directly) from the USPTO during the time period from when my firm was first engaged on behalf of WHD.

On 12/29/2005, I continued work on this petition. I also placed yet another telephone call to Karl Hormann, at 1-617-491-8867, and left another voice message.

On 12/30/2005, Laba Karki wrote to Mr. Martin Hennings regarding the status of WHD's

publicly unavailable US applications stating that:

Dear Mr. Hennings:

Further to our communication sent on 12/28/2005 regarding the status of the publicly unavailable US applications, we would like to enquire whether you would like us to revive the following abandoned applications.

HENN0010UPCT-US      08/894,766      Status: Abandoned on 11/3/1999      Due to failure to respond to office action

HENN0012UPCT-US      09/485,734      Status: Abandoned on 08/20/2003      Due to failure to respond to office action

HENN0014UPCT-US      09/719,881      Status: Abandoned on 10/06/2003      Due to failure to respond to office action

HENN0017UPCT-US      10/110,600      Status: Abandoned on 03/04/2004      During Pre-exam stage.

HENN0016UPCT-US      09/423,274      Status: Abandonment on 10/11/01      For Failure to Correct Drawings/Oath/NonPub Request

We look forward to receiving your instructions regarding revival of any or all of the above identified abandoned US applications.

Thank you for your attention to this matter.

Laba Karki

On 1/10/2006, Mr. Martin Hennings sent the following email to Laba Karki indicating his intention to revive the following applications stating that:

Dear Mr Karki,

please try to revive following applications:

HENN0010UPCT-US	08/894,766
HENN0012UPCT-US	09/485,734
HENN0014UPCT-US	09/719,881
HENN0017UPCT-US	10/110,600

According to the last listed application (HENN0016UPCT-US 09/423,274) it was agreed not to proceed with this application as already indicated in my previous email.

Best regards,

Martin Hennings

On February 2, 2006, Bruce Margulies wrote the following email to Rick Neifeld in response to Rick's query regarding obtaining the File Wrapper (FW) for the publicly unavailable applications from the USPTO stating that:

Rick,

I will fax a request for file wrappers for:

HENN0010UPCT-US we need a specification

HENN0012UPCT-US we need a specification

HENN0014UPCT-US we need a copy of the claims

HENN0017UPCT-US we need an office action; I'm not sure if the preliminary amendment in our paper file has been filed.

Bruce

-----Original Message-----

From: Rick Neifeld

Sent: Thursday, February 02, 2006 6:10 PM

To: Bruce Margulies; Laba Karki

Cc: Daniel Sachs; 'Martin Hennings Esq. (martin.hennings@arcor.de)'

Subject: RE: ResponsesNeeded\_HENN0002\_060202

Importance: High

Bruce - Please proceed to take all steps necessary to revive these application in Laba's absence (while he studies for the bar exam).

We requested another power, a power executed by the inventor. That power would have facilitated our contractor getting a copy of the applications. We have not received that power. Accordingly, take what action you need to get a copy from the USPTO.

thanks, RICK

On February 28, 2006 Bruce Margulies wrote to Laba Karki regarding the status of the file wrappers for applications 09/485,734 and 10/110,600 stating that:

Laba,

Here is an update on HENN0012UPCT-US and HENN0017UPCT-US.

Today, we received a copy of the file for HENN0012UPCT-US from the USPTO.

HENN0017UPCT-US did not have a recorded assignment. I recorded the assignment and then refiled our revocation and power of attorney. You will need to call the USPTO and confirm that they have us listed as attorney of record. Once you have confirmed this, you will need to resend a request to the USPTO for a copy of the application file. I had already done so twice, so you can refer to the copies in the file.

Let me know if you have any questions.

Bruce

On March 3, 2006 Mr. Martin Hennings wrote the following reply in response to Laba Karki's request for mass power of attorney form signed by the inventor in order to retrieve the publicly unavailable applications at the USPTO stating that:

Dear Laba,

please find attached the requested document signed by one of the inventors, Mr Torsten Wolf. Unfortunately it is not easy to get signatures from other inventors but I will forward it to you as soon as I receive it from WHD.

Best regards,

Martin

----- Original Nachricht -----

Von: Laba Karki <lkarki@neifeld.com>

An: martin.hennings@arcor.de

Datum: 21.12.2005 17:53

Betreff: RE: Mass Power of Attorney

Dear Mr. Hennings:

>

> Attached please find a form for "Mass Power of Attorney" for the US

> applications listed in the form. Please ask the inventor(s) of each

> of the listed application sign and date this form and send it to us.

> This will allow us to gain access to the files at the USPTO especially

> to the ones that are not publicly available.

>

> Thanks,

> Laba

On March 10, 2006 Bruce Margulies reported to Dr. Rick Neifeld the status of some of the WHD applications pending before the USPTO stating that:

HENN0017UPCT-US

Application No: 10/110,600

Filed 4/10/2002

Former Attorney No: 010491-US

Rick,

Here is the status of my efforts to obtain a copy of this file from the USPTO. Our most recent filing was February 27, 2006 containing a copy of the recorded assignment and the revocation and new power of attorney naming Neifeld IP Law, PC as the attorney of record. Once we are recognized by the USPTO as the attorney of record, I will order a copy of the file. Once we have the copy of the file, we can address issues related to reviving the application. I have called the PCT Help Desk to see if the filing of 2/27 has been recorded and have been told that it should be another 2-3 weeks at minimum.

Complicating matters is that the application went abandoned before the USPTO converted its files to digital files, so there is no digital file for this application.

My most recent call today was to Harry Kim of the PCT Legal Office (571) 272-4300. He brought up the possibility that the 371(c) requirements may not have been met and the possibility that the application was not fully converted to the US national stage. He said that the actual paper file is currently with Tech Center 2600 and that he would request the paper file and contact me by phone when he has the file.

I will save a copy of this email for evidence in a petition and I will set a docket reminder to call Mr. Kim if he has not gotten back to me in two weeks.

Bruce Margulies  
Attorney  
Neifeld IP Law, PC  
4813-B Eisenhower Avenue  
Alexandria, Virginia 22304  
Tel: 703-415-0012 Ext. 22  
Fax: 703-415-0013

On March 15, 2006 Mr. Martin Hennings sent the following email to Laba Karki instructing him not to revive some of the WHD cases that went abandoned at the USPTO stating that:

Dear Laba,

Thanks for your email! I confirm that all three cases indicated in your email should not be revived. According to your question please provide me with your estimation of additional costs in case that you would forward all documents to my office. Is there any kind of document that could help WHD to claim damages from Mr Hormann?

Best regards,

Martin

----- Original Nachricht -----

Von: Laba Karki <lkarki@neifeld.com>

An: martin.hennings@arcor.de

Datum: 13.03.2006 22:27

Betreff: AbandonmentProcedure\_HENN0001cases\_060313

> Dear Martin,

> As per your request in your previous communications to us, we did not



> attempt to revive the following applications.

> Neifeld Reference	Application S/N	Hennings Reference
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> HENN0016UPCT	S/N 09/423,274	1.157.US
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> HENN0018UPCT	S/N 10/469,794	1.260.US
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> HENN0019UPCT	S/N 10/469,795	1.258.US
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>

> Please reconfirm that the above identified applications are correct.

> Accordingly, we want to follow our firm procedures for voluntary

> abandonment. We have both the electronic and paper records of the

> documents that you sent us.

>

> Please inform us whether 1) you wish to have the paper files discarded

> and the electronic record deleted or 2) whether you would like us to

> forward the documents back to your office.

> Thanks,

> Laba

>

On March 15, 2006 Mr. Martin Hennings sent the following reply in response to Dr. Rick Neifeld's question regarding sending the documents back to Mr. Hennings for claiming damages against the former counsel Mr. Hormann stating that:

Thanks, Rick!

Up to now it is not yet decided who WHD will claim damages. Therefore please forward all documents back to my office.

Best regards,

Martin

----- Original Nachricht -----

Von: Rick Neifeld <rneifeld@neifeld.com>

An: martin.hennings@arcor.de, lkarki@neifeld.com

Datum: 15.03.2006 16:36

Betreff: RE: AbandonmentProcedure\_HENN0001cases\_060313

Martin - I should answer your questions.

>

> I estimate it will cost \$150.00 for shipping the files back to you;

> admin cost and courier costs.

>

> Evidence is always useful in court proceedings. The paper patent

> files represent such evidence. Of course, you would have to actually

> pursue a claim for damages, for that evidence to be useful in respect

> of a court proceeding. Rick

On March 15, Rick Neifeld sent the following message to Laba Karki and Bruce Margulies stating that:

Please update the petition to revive showing the facts leadign to the additional delay. I will resign the new petition.

Rick Neifeld, Ph.D. Patent Attorney

President

Neifeld IP Law, PC URL: [www.Neifeld.com](http://www.Neifeld.com) StockPricePredictor.com, LLC URL:

[www.PatentValuePredictor.com](http://www.PatentValuePredictor.com) 4813-B Eisenhower Avenue Alexandria Virginia 22304

Tel: 703-415-0012

Fax: 703-415-0013

On March 15, Rick Neifeld sent the following message to Laba Karki and Bruce Margulies

stating that:

there is an amendment bruce bounced today; that case is the case to which I refer.  
thanks, RICK

-----Original Message-----

From: Laba Karki  
Sent: Wednesday, March 15, 2006 12:55 PM  
To: Rick Neifeld  
Cc: Bruce Margulies  
Subject: RE: petition to revive

Rick,

I did add the additional facts to the petition leading to the additional delay into the petition for the case HENN0012UPCT-US, i.e., relevant discussion on ordering and receipt of FW from the USPTO.

However, for the HENN0017UPCT-US case, Bruce will enter those other relevant facts when we receive the FW.

Thanks,  
Laba

-----Original Message-----

From: Rick Neifeld  
Sent: Wednesday, March 15, 2006 12:10 PM  
To: Laba Karki; Bruce Margulies  
Subject: petition to revive  
Importance: High

Please update the petition to revive showing the facts leadign to the additional delay. I will resign the new petition.

Rick Neifeld, Ph.D. Patent Attorney

President

Neifeld IP Law, PC URL: [www.Neifeld.com](http://www.Neifeld.com) StockPricePredictor.com, LLC URL:

[www.PatentValuePredictor.com](http://www.PatentValuePredictor.com) 4813-B Eisenhower Avenue Alexandria Virginia 22304

Tel: 703-415-0012

Fax: 703-415-0013

On March 15, 2006 at 3:00 PM Dr. Rick Neifeld gave verbal instructions to Dr. Laba Karki to provide supplemental facts into the petition to revive and to amend the 37 CFR 1.111 amendment response as per Bruce Margulies corrections.

**37 CF 1.137** read in pertinent part:

§ 1.137 Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(b) Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph **to revive an abandoned application**, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) **The reply required to the outstanding Office action or notice**, unless previously filed;

(2) **The petition fee as set forth in § 1.17(m);**

(3) **A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.** The Director may require additional

information where there is a question whether the delay was unintentional; and

**(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.**

(c) Reply. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(d) Terminal disclaimer.

(1) Any petition to revive patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

**(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.**

(c) Reply. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an

application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(d) Terminal disclaimer.

(1) Any petition to revive pursuant to this section in a **design application** must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a **utility or plant application filed before June 8, 1995**, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c) from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph

(d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, to reissue applications, or to reexamination proceedings.

(e) Request for reconsideration. Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated

reexamination proceeding, or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

- (1) The provisions of § 1.136 for an abandoned application or lapsed patent;
- (2) The provisions of § 1.550(c) for a terminated ex parte reexamination proceeding filed under § 1.510; or
- (3) The provisions of § 1.956 for a terminated inter partes reexamination proceeding filed under § 1.913.

### **III. Statement of the Reasons Why the Relief Requested Should be Granted**

#### **A. Requirements to grant the petition**

**The entire delay in filing the required reply from the due date for the reply until the filing of this grantable petition was unintentional.**

**This petition is accompanied by a reply to the outstanding Office action or notice.**

**This petition is accompanied by the fee set forth in § 1.17(m) (\$1500 dollars for large entities and \$750 for small entities according to the USPTO web site list of fees as of 12/29/2005 posted at**

**<http://www.uspto.gov/web/offices/ac/qs/ope/fee2005oct01.htm>).**

**This application was filed after 12/8/2005, and it is a utility application. Therefore, no terminal disclaimer is required to grant this petition.**

The foregoing shows the regulatory requirements for granting a petition to revive are satisfied.

#### **B. Diligence upon Discovery and lack of Intent to Abandon**

WHD elektronische Prueftechnik GmbH (WHD) indicated to me, via its local German

patent attorney, Martin Hennings, that it had no intention of abandoning this application. Hence, the abandonment was unintentional. The email exchanges between myself and Martin Hennings show that WHD did not know that this application was in fact abandoned until late in November 2005, when WHD's prior German patent attorney checked the USPTO web site for status of WHD U.S. patent applications.

The email exchanges between myself and Martin Hennings noted above in the facts section show that WHD took *prompt* action, via its current German patent attorney, Martin Hennings, to determine the facts and attempt to revive the applications. They also show that my firm and I took prompt action to ascertain the facts necessary to prepare this petition; determining the scope and content of the WHD portfolio, inquiring on the intent issue with both WHD and WHD's prior U.S. counsel. WHD has been responsive. WHD's prior US counsel, Mr. Hormann, has not yet been responsive. As of 12/16/2005, I had spoken with Mr. Hormann twice, and sent him a facsimile. Since that time, I had placed several more telephone calls (3 to 5) and left voice messages each time, none of which were returned. In my first conversation, Mr. Hormann indicated to me that he had just left a hospital, and would call me back the next day. About 2 days later, I called Mr. Hormann again, and he told me at that time that he had received my facsimile, but that he was very busy and would telephone me the following day. As of 12/29/2005, despite my repeated telephone calls and voice messages, I have not received further communications from Mr. Hormann.

My email exchanges show that, on November 22, 2005, I provided information necessary for Martin to counsel WHD and request instructions.

Martin responded with his clients instructions on December 8, 2005, along with image copies attached to his email, of all records he could obtain regarding WHD's U.S. patent applications, instructing me to petition for revival of this and other applications. Those records were clearly incomplete.

From that time on, I acted diligently to acquire the facts necessary to make this petition, including ascertaining to my satisfaction that there was no evidence of intentional abandonment. I reviewed the partial files Mr. Henning sent me from WHD's records, reviewed the data publicly available from the USPTO via its PAIR, USP, and PGP data servers, had the available IFWs



downloaded, repeatedly contacted Mr. Hormann requesting his help and factual information.

Lacking attorney files, determining status of an application (pending, abandoned, or issued) and how to respond on the merits to any outstanding actions is a difficult if not impossible process. For example, as part of that process, Laba Karki and I generated a spreadsheet of the formal data we could gather for the WHD application that, as of about 12/16/2005, contained 260 cells (13 identified applications and 20 cells of data for each application's record) attempting to determine status and relationships between identified WHD applications.

For some time, I did not know for certain the status of many of the applications, or whether additional applications filed by Mr. Hormann on behalf of WHD existed. During the course of my review of the formal data, I did identify at least one instance in which PAIR showed that Mr. Horman assigned the same attorney reference to two different applications.

In any event, I did satisfy myself, upon investigation, that WHD had no intent to abandon this application. Accordingly, this petition to revive should be granted. Further, my interactions with Mr. Hormann objectively show (via his lack of communication) that he is incompetent, thereby implying a lack of intent on his part. Moreover, if Mr. Hormann did have an intent to abandon this WHD application, that would have been beyond his representative authority since it was contrary to his client's instructions. Hence, I am satisfied that there was no intent upon any party to abandon this application.

3/16/06  
Date

Respectfully submitted



Richard Neifeld

Registration No: 35,299

Attorney of record

RAN/lk

March 16, 2006 (12:22pm)

Y:\Clients\Hennings\HENN0012\HENN0012UPCT-US\Drafts\PeitionToRevive\_HENN0012U  
PCT-US\_060113.wpd

DOCKET NO: HENN0012UPCT-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: FRANK PUTTKAMMER

APPLICATION NUMBER: 09/485,734

CONFIRMATION NO:2153

GROUP: 2876

EXAMINER: CAPUTO, LISA

FILED: February 14, 2000

FOR: Constituting security elements with optical diffraction effect, and device for controlling such elements

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

**RECEIVED**

**MAR 23 2006**

**OFFICE OF PETITIONS**

37 CFR 1.111 AMENDMENT

Sir:

In response to the non-final office action mailed May 19, 2003, and in addition to the petition to revive filed herewith, please enter the following amendment and consider the following response.

Amendment to the Abstract begin on page 2

Amendments to the Specification begin on page 3 of this paper.

Amendments to the Claims begin on page 7 of this paper.

Remarks begin on page 11 of this paper.

## **I. Amendment to the Abstract**

Please add the following abstract to the “Abstract” section

### **ABSTRACT**

The invention concerns the constitution of security elements with optical diffraction effect, and a device for controlling such elements. The use of holograms and other security elements with optical diffraction effect for protecting documents and other valuable papers, as well as bank notes against forgery is becoming more and more frequent presently. The element with optical diffraction effect comprises a discontinuous metal coating and/or partial metal coats and/or metal coat zones in different planes, representing an electric data coding, corresponding to the objective. The device comprises a scanner with capacitive functioning, said scanner consists of a plurality of emitting electrodes placed side by side and a receiving electrode extending parallel to said emitting electrodes arrangement.

## II. Amendment to the Specification:

On page 1 at lines 1-4, please replace the title with the following title:

### TITLE OF THE INVENTION

~~Structure of security Elements Effective by Optical Diffraction and Apparatus for Examining Such Elements~~ Constituting Security Elements with Optical Diffraction Effect and Device For Controlling Such Elements

### CROSS REFERENCE TO RELATED APPLICATIONS

Not Applicable

### STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT

Not Applicable

### INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC

Not Applicable

On page 1, please replace the paragraph at lines 6-7 with the following paragraph:

### BACKGROUND OF THE INVENTION

#### 1. Field of the invention

The invention relates to the structure of security elements effective by optical diffraction and to an apparatus for examining such elements.

On page 1, please replace the paragraph at lines 9-25 with the following paragraph:

#### 2. Description of the Related Art

Hitherto, documents with security elements effective by optical diffraction, in particular holograms, are controlled by complex optical testing technology. In such a process the test object must be positioned with great precision. The entire examination process takes so much

time that such examination methods cannot be applied in fast-moving processing machines. It is not possible to examine documents provided, for instance, with so-called optically variable devices (OVD) within a document processing machine because it is operating at high speed. In U.S. patent 4,255,652 there is described an apparatus for detecting identification indicia in documents provided with electrically conductive areas. An electric charge is transmitted to one of the electrically conductive areas by means of a first capacitive element extending across and arranged over ~~[[with]]~~ the width of the document. As the document to be examined is moved further, the charged electrically conductive moves under a second capacitive element extending across the ~~[[with]]~~ width of the document to be examined, by means of which the charge is withdrawn. An evaluation and decoding circuit will then generate a typical signal function.

On page 3, please replace the paragraph at lines 8-16 with the following paragraph:

#### OBJECTS OF THE INVENTION

~~It is the task~~ An object of the invention is to eliminate the disadvantages of the state of the art and to propose a structure of security elements effective by optical diffraction, particularly OVD's, holograms or kinegrams, which may be examined quickly, without human intervention and with insignificant effort. Furthermore, ~~it is a task~~ an object of the invention is to propose an apparatus for examining documents containing such security elements. The apparatus is to be used in document processing machines as well as ~~[[is]]~~ in manual testing apparatus for examining document provided with security elements effective by optical diffraction.

On page 3, please replace the paragraph at line 18 with the following paragraph:

These ~~tasks~~ objects are accomplished by the invention hereinafter described.

On page 3, please replace the paragraph at lines 19 through page 4 line 6 with the following paragraphs:

The use of holograms and other security elements effective by optical diffraction for making certificates and other securities as well as banknotes secure against counterfeiting are

currently ever more prevalent. Such documents are, for instance, the 1997 series of German marks which in addition to electrically conductive security strips possess a security element effective by optical diffraction formed by a kinegram. The capability of quick examination represents a further security stage in the evaluation of the elements effective by optical diffraction as a mark of genuineness.

#### BRIEF SUMMARY OF THE INVENTION

Elements which are effective by optical diffraction are made up of a metallized layer, among other things. This metallization layer is electrically conductive. The electrical conductivity changes in accordance with the layer thickness. In accordance with the invention, the element effective by optical diffraction is provided with a discontinuous metallization layer and/or partially metallized layers and/or zone of metallized layers in different planes which represent a target-oriented electrical encoding of data. The shape of the encoding resembles geometric figures, more particularly lines, grid-lines, bows and/or circles arranged orderly as well as at random. A partially metallized layer arranged above the support layer contains several demetallized segments. A discontinuous metallization layer contains segments of different electrical conductivity.

On page 5, please replace the paragraph at lines 8-17 with the following paragraph:

Aside from the software for the micro-processor there are stored in the memory reference signal images which are compared against the signal image of the document being examined. Since the scanner extends across the entire width of the document every electrically conductive characteristic will be detected by the apparatus in accordance with the invention. The comparison against the reference signal image generates a classifying signal for further processing. Accordingly, a document detected as a forgery, for instance, could be removed by stopping the examining apparatus. ~~[[The]]~~ To reduce interference the sensor support is connected to a platen for supporting the electronic energizing and evaluating circuits.

On page 6, please replace the paragraph at lines 14-19 with the following paragraph:

### BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S)

~~The characteristics of the invention are apparent not only from the claims but also from the specification and the drawings, whereby individual characteristics may define advantageous patentable embodiments either by themselves or with others as sub-combinations, for which protection is applied for here. Embodiments of the invention are depicted in the drawings and will be described in greater detail hereinafter.~~

The novel features which are considered to be characteristic of the invention are set forth with particularity in the appended claims. The invention itself, however, in respect of its structure, construction and lay-out as well as manufacturing techniques, together with other objects and advantages thereof, will be best understood from the following description of preferred embodiments when read with reference to the appended drawings, in which:

On page 7, please replace the paragraph at lines 17-28 with the following paragraph:

### DETAILED DESCRIPTION OF THE INVENTION

The examples of Figs. 1-5 depict documents provided with security elements in accordance with the invention, all of which contain target-oriented electrical encoding. The encoding is not carried out as an encryption of any kind of data but rather electrically conductive examination indicia are set up in a target-oriented manner by an arrangement of electrically conductive structures relative to each separated by non-conductive structures, the electrical encoding of which will generate a predetermined signal pattern by means of the test apparatus in accordance with the invention, the signal pattern being compared to an established stored reference signal pattern. This results in the intended high test speed. The capacitively operating scanner of the apparatus in accordance with the invention has also been schematically shown.

### SEQUENCE LISTING

Not Applicable



### III. Amendment to the Claims:

1. (Currently amended) Structure of optically effective diffraction security elements in documents, ~~characterized by the fact that~~ wherein the optically effective diffraction security element is provided with target-oriented electrical encoding of data consisting of a discontinuous metallization layer and/or partially metallic conductive layers and/or zones of metallic layers in different planes.

2. (Currently amended) Structure according to claim 1, ~~characterized by the fact that~~ wherein the form of the encoding resembles figures, in particular lines, grid-lines, bows and/or circles.

3. (Currently amended) Structure according to claim 1, ~~characterized by the fact that~~ wherein the form of the encoding resembles orderly or randomly arranged geometric figures, in particular lines, grid-lines, bow and/or circles.

4. (Currently amended) Structure according to claim 1, ~~characterized by the fact that~~ wherein a demetallized zone (3) in top elevation is of meandering form.

5. (Currently amended) Structure according to claim 1, ~~characterized by the fact that~~ wherein metallized strip-like zones (7) and demetallized strip-like zones (8) are arranged alternately, whereby in top elevation the strip-like zones are extending parallel or vertically relative to the document feed direction.

6. (Currently amended) Structure according to claim 1, ~~characterized by the fact that~~ wherein the distance between two zones of the same or dissimilar electrical conductivity corresponds to the shortest distance between two electrodes.

7. (Currently amended) Structure according to claim 6, ~~characterized by the fact that~~

wherein the distance between two zones of the same or dissimilar electrical conductivity is at least 0.1 mm.

8. (Currently amended) Structure according to ~~[[one or more]]~~ any one of the preceding claims, ~~characterized by the fact that~~ wherein the metallized zones (7) are interrupted by one or more demetallized zones (9) extending vertically thereto.

9. (Currently amended) Structure according to ~~one or more of the preceding claims~~ claim 8, ~~characterized by the fact that~~ wherein the optically effective diffraction security element is an OVD (1).

10. (Currently amended) Structure according to ~~one or more of the preceding claims~~ claim 8, ~~characterized by the fact that~~ wherein the optically effective diffraction security element is a hologram.

11. (Currently amended) Structure according to ~~one or more of the preceding claims~~ claim 8, ~~characterized by the fact that~~ wherein the optically effective diffraction security element is a kinegram.

12. (Currently amended) Apparatus for examining documents provided with optically effective diffraction elements with a metallic reflection layer as described in claim[[s]] 1 ~~[[to 11]]~~, characterized by a capacitively operating scanner (4) the width of which is larger than the largest width of a document, consisting of a linear array of a plurality of electrodes disposed in side by side relationship, an electronic energization circuit and an electronic evaluation circuit for comparing the signal pattern of the document to be examined against corresponding reference signal patterns.

13. (Currently amended) Apparatus according to claim 12, ~~characterized by the fact that~~ wherein a plurality of electrodes are disposed side by side and/or in several rows whereby a

receiving electrode (6) or a transmitting electrode (17) extends parallel to a plurality of transmitting electrodes (5) disposed in side by side relationship or a plurality of receiving electrodes (18) disposed in side by side relationship, respectively.

14. (Currently amended) Apparatus according to claim 12, ~~characterized by the fact that wherein~~ the electronic energization circuit consists of a current source, a multiplexer (10), an oscillator (11) for providing energy to the transmitting electrodes (5) and an oscillator (12) for energizing the multiplexer (10).

15. (Currently amended) Apparatus according to claim 12, ~~characterized by the fact that wherein~~ the electronic evaluation circuit consists of a current source, an amplifier (13), a demodulator (14), a comparator (15), a micro-processor (16) provided with a memory as well as with filters for the suppression of extraneous and interference signals.

16. (Currently amended) Apparatus according to ~~one or more of~~ any one of preceding claims 12 to 15, ~~characterized by the fact that wherein~~ the smallest distance between electrodes is less than 0.5 mm.

17. (Currently amended) Apparatus according to ~~one or more of~~ claim[[s]] [[12 to]] 16, ~~characterized by the fact that wherein~~ the distance between a transmitting electrode (5) and the receiving electrode (6) is at least 0.5 mm.

18. (Currently amended) Apparatus according to ~~one or more of~~ claim[[s]] [[12 to 17]] 16, ~~characterized by the fact that wherein~~ the apparatus is arranged in fast-running document processing machines.

19. (Currently amended) Apparatus according to ~~one or more of~~ claim[[s]] [[12 to 18]] 16, ~~characterized by the fact that wherein~~ the apparatus is arranged in manual devices.

20. (Currently amended) Apparatus according to ~~one or more of claim[[s]] [[12 to 19]]~~ 16,  
~~characterized by the fact that~~ wherein the apparatus is arranged in document reading devices.

21. (Currently amended) Apparatus according to ~~one or more of claim[[s]] [[12 to 20]]~~ 16,  
~~characterized by the fact that~~ wherein the scanner is arranged across the entire width of the  
document such that visually distinctly perceptible optically effective diffraction security elements  
of the same electric properties on one and the same document are compared by means of a  
micro-processor.

22. (Currently amended) Apparatus according to ~~one or more of claim[[s]] [[12 to 21]]~~ 16,  
~~characterized by the fact that~~ wherein the scanner is arranged across the entire width of the  
document such that visually similar[[ly]] perceptible optically effective diffraction security  
elements on one and the same document are compared by means of a micro-processor.

## REMARKS

### **I. Front Page of Office Action and Claim Status**

The front page of the May 19, 2003 office action indicates that Claims 1-8 are rejected and that Claims 9-22 are objected to as being in improper form.

### **II. Claim Status**

Claim 1 is the only independent claim. Claims 1-22 are amended. The specification as originally filed fully supports the amended claims. Therefore, no new matter has been added.

### **III. The Objection to the Oath/Declaration**

The examiner objected to the oath/declaration stating that the title in the declaration ("Constituting Security Elements with Optical Diffraction Effect, and Device for Controlling Such Elements") did not match the title of the actual specification ("Structure of Security Elements Effective by Optical Diffraction and Apparatus for Examining Such Elements").

In response, the applicant amends the specification to correct the title to match the title in the inventor declaration form.

### **IV. The Objection to the Specification**

The examiner objected to the specification for not complying with the formality requirements under 37 CFR 1.77 (b). See office action mailed on May 19, 2003 at page 2. The examiner also objected to informalities in the specification at page 5 line 15.

In response, applicant has provided appropriate section headings in the specification and corrected the noted informalities. Applicant also submits an abstract for the specification .

### **V. Formal Drawings**

Applicant submits formal drawings for figures 1-14.

## **VI. Claim Objections**

On page 3 of the office action mailed on May 19, 2003, the examiner objected to the use of non-specific conjunction “and/or” in claims 1-3.

In reply, the applicant has amended claims 1-2 to correct the spelling error for “and/or”. However, the objection to the use of [and/or] phrase in claims 1-3 should be withdrawn because the use of [and/or] conjunction to define the scope of the claim is routine and common practice in drafting patent claims. For example, some recently issued patents such as USPs 7,010,799; 7,010,798; 7,010,790; 7,010,664 use the “and/or” phrase in defining their claim scope. Accordingly, applicant respectfully requests that this objection be withdrawn.

On page 3 of the office action mailed on May 19, 2003, the examiner objected to claims 9-22 under 37 CFR 1.75(c) as being in improper form because these claims depended from another multiple dependent claim.

In reply, the applicant has amended dependent claims 9-22 to remove the problem of multiple dependent claims depending on other multiple dependent claims.

## **VII. The Rejections of Claims 1-8 Under 35 USC 102 as Being Anticipated by Edwards (US Patent No. 5,388,862) is Improper and Should be Reversed**

On page 4 of the office action mailed on May 5, 2003 the examiner rejected claims 1-8 as being allegedly anticipated by Edwards stating that:

Edwards teaches a security article having all of the elements and means as recited in claims 1-8 of the instant application. Edwards discloses that according to the present invention there is provided a security article which comprises at least one elongate security element, the security element being visually detectable in transmitted light to display portions which transmit light and portions which are opaque, wherein the security element comprises a plurality of layers including a light-transmitting support layer and two or more series of opaque regions which are separated by at least one light transmitting layer, which may be the support layer, characterised in that the opaque regions are arranged such that at certain parts of the security element the said regions overlap to prevent light transmission and elsewhere along the length of the security

element the opaque regions do not overlap or partially overlap such that light transmission through the security element can occur. By the term "opaque regions" it is to be understood that such regions in the security element transmit significantly less light when viewed with the naked eye in comparison to the transmissive regions of the security element between such opaque regions and in comparison with the regions of the security paper, etc. adjacent to the security element. Preferably the security article is security paper and the security element is either wholly embedded within the paper, or is partially embedded within said paper with portions thereof being exposed at the surface of the paper at spaced intervals along the length of the security element at windows or apertures in the paper. Preferably there is also present between the series of opaque regions at least one and preferably two thin layers of metal, which layer or layers has a combined optical density of 0.1 to 1.2, preferably from 0.3 to 0.9. Such a thin layer of metal, if made of aluminum, which is preferred, serves to render the security element less visible when viewed in reflected light. In one embodiment in the paper the security element of this invention when viewed in reflected light has characteristics not significantly different from the prior art security element made from vacuum deposition of aluminum on to a polyester support, although, of course, the appearance of the security element of this invention is radically different when viewed with transmitted light. In a preferred embodiment of the invention security paper includes a security element formed from two parts, one part bearing on one side of a light-transmitting support layer opaque, spaced-apart regions of aluminum and on the other side of the support layer a thin film of aluminum, which part is adhered another part which comprises a light-transmitting support layer having on one side a thin film of aluminum, the two layers of thin aluminum having a combined optical density of 0.15 to 1.0, and on the other side of the support layer opaque spaced-apart regions of aluminum, said two parts being united with an adhesive layer positioned between the two thin layers of aluminum (see col 2, lines 7-63). Hence, regarding claim 1 Edwards teaches a structure of optically effective diffraction security elements in a document wherein the security element is provided with target-oriented encoding of data that consists of a discontinuous metallization layer.

Further, Edwards discloses that the metallised regions 2A and 28 extend across the security element and may be in a bar pattern as shown in FIGS. 2 and 3 of the accompanying drawings; also, FIG. 4 indicates an alternative pattern that can be used in practice of the invention. In FIGS. 2,3 and 4 the top half of the security element is shown in plan view to indicate suitable patterns for the aluminum regions 2A, with the resist 3A lying over the aluminum (see Figures 2-4, col 5, lines 32-41). Figures 2-4 show the different geometric shapes (i.e. lines, meandering form) that the encoding resembles as recited in claims 2-5 and 8 of the instant application. [Office action mailed on May 19, 2003 at pages 4-6]

In response, the applicant respectfully traverses the rejection of claim 1 because Edwards does not disclose the *optically active diffraction security elements* in documents effected by the security feature having discontinuous metallized and/or demetallized zones. Nor does Edwards teach *target oriented electrical encoding* of data by the optical diffraction security element. The structure of security elements effective by optical diffraction include OVDs, holograms and kinegrams. Figures 1-5 provide examples of claim 1. For example, figure 2 shows a document with an optically variable device (OVD). This OVD consists of a strip- shaped metallization layer 8 and a strip-shaped demetallized zone 7 extending in parallel configuration. See page 8 line 5 through line 11 of the specification. The following passage in the specification discloses how elements effective by optical diffraction such as OVDs are used stating that:

Hitherto, documents with security *elements effective by optical diffraction*, in particular holograms, are controlled by complex optical testing technology. In such a process the test object must be positioned with great precision. The entire examination process takes so much time that such examination methods cannot be applied in fast-moving processing machines. It is not possible to examine documents provided, for instance, with so-called optically variable devices (OVD) within a document processing machine because it is operating at high speed. [Emphasis supplied, Specification at page 1 lines 9 through 16.]



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German patent DE 27 47 156 describes a method and a testing apparatus for examining the genuineness of holographically secured identity cards. The OVD is reproduced and a visual control is executed. This process is unsuited for an examination which is quick and efficient and which can be performed independently of personal intervention. European patent EP 0,042,946 describes an apparatus for the generation of scanning patterns which are examined by laser, mirror and lens systems as well as a photo-detector. In this case, too, the economic complexity is very high. It increases even more where the material to be examined is to be tested in an unsorted state.  
[Specification at page 2 lines 21 through 30.]

The following passage in the specification explains that an OVD provides optical diffraction stating that:

It is the task of the invention to eliminate the disadvantages of the state of the art and to propose a structure of security elements effective by optical diffraction, *particularly OVD's, holograms or kinegrams*, which may be examined quickly, without human intervention and with insignificant effort. Furthermore, it is a task of the invention to propose an apparatus for examining documents containing such security elements. The apparatus is to be used in document processing machines as well as in manual testing apparatus for examining document provided with security elements effective by optical diffraction. [Emphasis supplied, specification at page 3 lines 8-16.]

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Elements which are effective by *optical diffraction* are made up of a metallized layer, among other things. This metallization layer is electrically conductive. The electrical conductivity changes in accordance with the layer thickness. In accordance

with the invention, the element effective by optical diffraction is provided with a discontinuous metallization layer and/or partially metallized layers and/or zone of metallized layers in different planes which represent a target-oriented electrical encoding of data. The shape of the encoding resembles geometric figures, more particularly lines, grid-lines, bows and/or circles arranged orderly as well as at random. A partially metallized layer arranged above the support layer contains several demetallized segments. A discontinuous metallization layer contains segments of different electrical conductivity. [Emphasis supplied, specification at pages 3 lines 26 through page 4 lines 6.]

**A. Claim 1**

Claim 1 as amended defines a structure of optically effective diffraction security elements in documents, characterized by the fact that the optically effective security element is provided with target-oriented electrical encoding of data consisting of a discontinuous metallization layer and/or partially metallic conductive layers and/or zones of metallic layers in different planes.

**B. Edwards**

Edwards is directed to visually detectable security elements against counterfeiting paper documents that comprises a plurality of layers including a light transmitting layer and series of opaque regions separated by light transmitting layers. See Edwards claim 1 and abstract. In particular, Edwards discloses security element with an arrangement of light transmitting regions and opaque regions such that at certain parts of the security element the said regions overlap to prevent light transmission and elsewhere along the length the opaque regions do not overlap or partially overlap such that light transmission through the security element can occur. See Edwards specification column 2 lines 17-23. Thus, Edwards is concerned with providing a security element in the form of a strip or thread of metallized and demetallized regions to enhance against counterfeiting. See Edwards specification column 1 lines 64-68 and figure 5.

**C. Comparing Edwards to Claim 1**

In contrast, claim 1 defines an optically effective diffraction security element

characterized by discontinuous metallization layer and or partially metallic conductive layers and/or zones of metallic layers in different planes.

Claim 1's security element is structured as an optically effective diffraction security element which comprises an optical variable device (OVD), holograms or kinegrams. See specification at page 3 lines 8-11. Furthermore, the element which is effective by optical diffraction (e.g., OVD) comprises metallized layers and demetallized or partially demetallized sections. Metallized means deposited and forming a layer and is electrically conductive and demetallized zones means regions where the metal layer have been removed and is electrically non-conductive. Further, the optical diffraction element comprising the metallized and demetallized regions represents a target oriented electrical encoding of data, which generates a predetermined electrical signal pattern.

In contrast, Edwards does not disclose an optically effective diffraction security element. Edwards discloses no metallized layer regions structured as a diffraction grating for optical diffraction. Edwards layer of metal serves to render the security element less visible when viewed in reflected light. See, Edwards specification column 2 lines 41-43. Whereas, the purpose of the layered metal regions in the security element in Edwards is to enhance security in banknotes against counterfeiting by visual inspection, the metallized and demetallized zones in claim 1 provide optical diffraction that represent a target oriented electrical encoding of data. Accordingly, the rejection of amended claim 1 is improper and should be withdrawn. Therefore, dependent claims 2-5 and 8 should also be held allowable.

#### **D. Claims 6-7**

The examiner rejected claims 6-7 stating that:

Regarding claims 6-7, Edwards discloses that with reference to FIG. 7, a web of colourless 12 .mu.m thick polyester 31A (e.g. EMBLET 1200) is vacuum coated with an opaque uniform layer of aluminum at an optical density of 2.0 to 2.5. The web is then partially demetallised to produce a bar pattern as described in Example 1. Conveniently,

the bars are 1.0 mm wide and spaced 1.0 mm apart, as represented by regions 32 in FIG. 7. After demetallisation, the bars have a resist coating 33A on their upper surface. A partially transmitting layer of aluminum 34A of an optical density 0.6 is then deposited over the web on the selectively demetallised side in a further vacuum deposition operation, such that this second metal layer is present over the resist layers 33A and in between the opaque metal layers 32A; this partially transmitting layer is designated 34A(see Figure 7, col 8, lines 49-64). Hence, Edwards teaches that the distance between two zones of electrical conductivity is the shortest distance between electrodes and further that the distance is at least .1 mm. [Office action mailed on May 19, 2003 page 6 through 7]

In reply, the applicant points out that dependent claims 6 and 7 provide further limitations of claim 1 in that the distance between two zones of the same or dissimilar electrical conductivity represent the shortest distance between two electrodes. Edwards does not teach plurality of receiving and transmitting electrodes. Also, nowhere does Edwards teach that the distance between two zones of electrical conductivity is the shortest distance between electrodes.

Rather, Edwards teaches partially demetallized layers on an uniform opaque layer of aluminum to produce a bar pattern such that the bars are spaced about 1.0 mm apart. This pattern in Edwards further increases the visual effect and complicates the counterfeiter's task. See column 7 lines 6-7. Thus, Edwards is not directed to optical diffraction effects created by the metallized and demetallized regions of the security element for target oriented electrical encoding of data. Accordingly, dependent claims 6 and 7 should also be held allowable.

VII. **Closure**

This application should now be in condition for allowance. Should the examiner have any questions, he is urged to contact the undersigned at 703-415-0012.

Respectfully Submitted,

\_\_\_\_\_  
Date

\_\_\_\_\_  
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3/16/2006  
Date

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LK

March 13, 2006 (1:30pm)

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REPLACEMENT SHEET

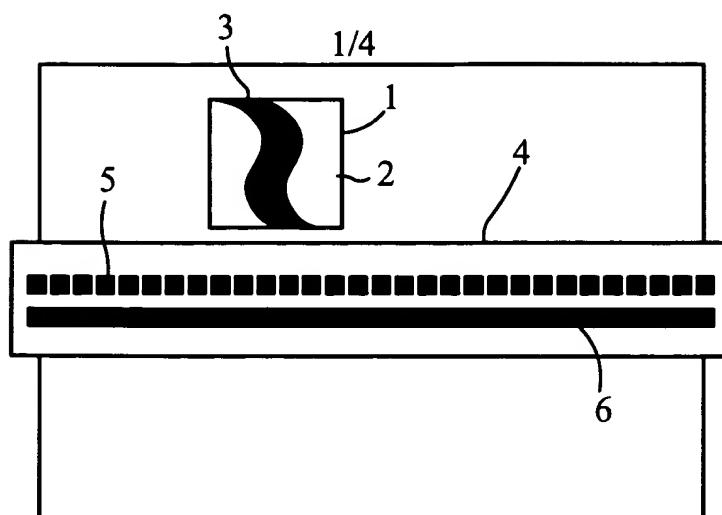


FIG. 1

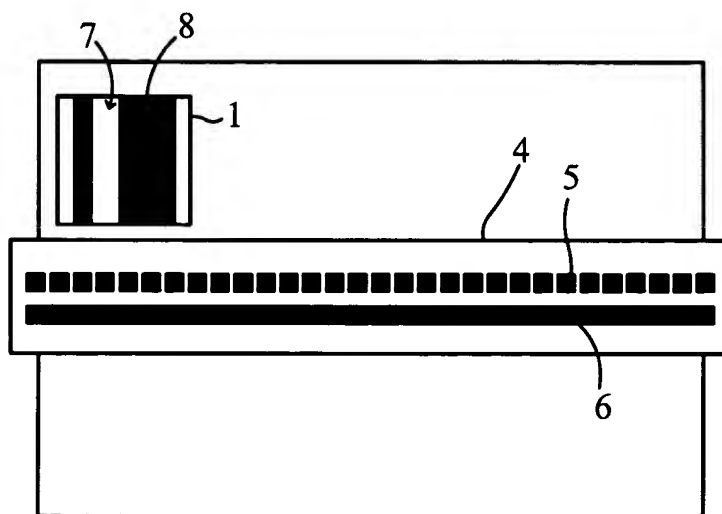


FIG. 2

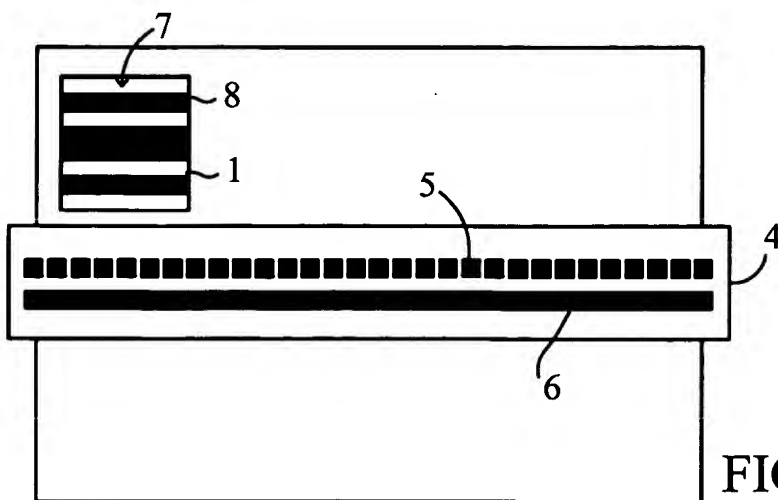


FIG. 3

# REPLACEMENT SHEET

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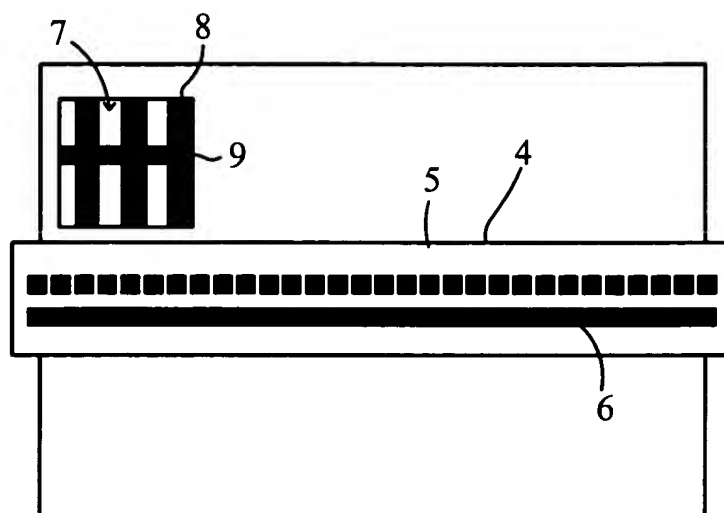


FIG. 4

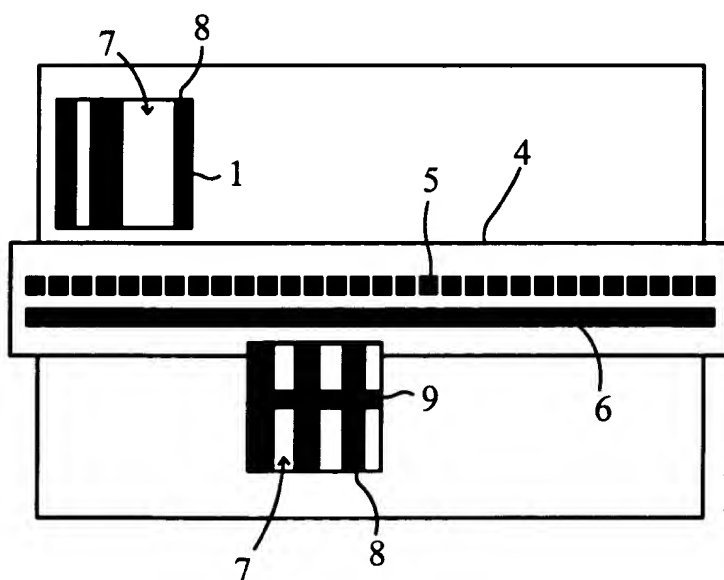


FIG. 5

REPLACEMENT SHEET

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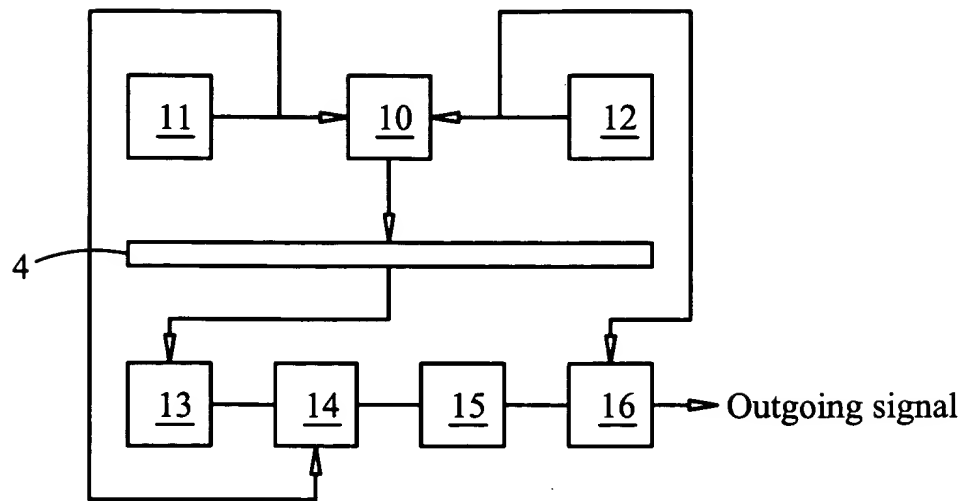


FIG. 6

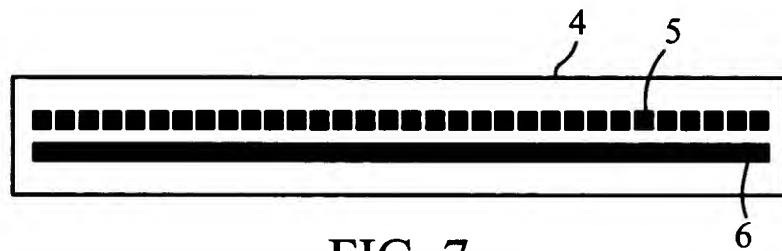


FIG. 7

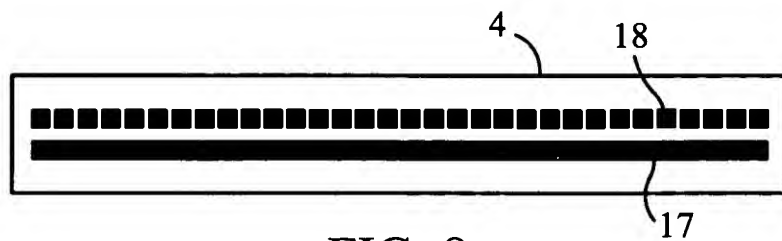


FIG. 8

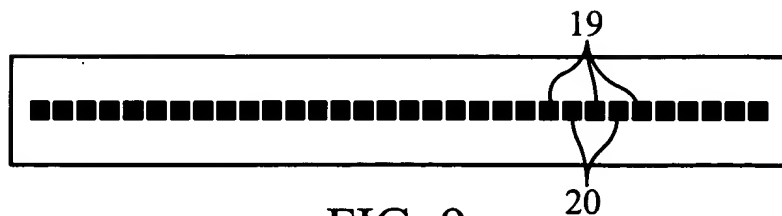


FIG. 9



# REPLACEMENT SHEET

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